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IN THE UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

In Re:
Katz Interactive Call Processing Patent
Litigation

This document relates to:

ALL "B" TRACK ACTIONS
(except CV 07-02254 RGK (FFMx))

Case Nos. CV 07-2096 RGK (FFMx), CV
07-2099 RGK (FFMx), CV 07-2101 RGK
(FFMx), CV 07-2134 RGK (FFMx), CV
07-2192 RGK (FFMx), CV 07-2196 RGK
(FFMx), CV-07-2213 RGK (FFMx), CV
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07-2360 RGK (FFMx), CV 07-3002 RGK
(FFMx)

Case No. CV 2:07-ml-01816-B-RGK
(FFMx)

**DEFENDANTS' MEMORANDUM IN
SUPPORT OF MOTION FOR
SUMMARY JUDGMENT OF
INVALIDITY OF RAKTL'S
SELECTED CLAIMS UNDER
SECTION 112**

Date: To Be Determined
Time: To Be Determined

Judge: Hon. R. Gary Klausner
Ct: Courtroom 850

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	INVALIDITY FOR LACK OF WRITTEN DESCRIPTION	1
A.	No Written Description In The Dual Call Mode Patents Of A Plurality Of Formats.....	3
B.	No Written Description In The Dual Call Mode Patents Of Unqualified Or Unverified Toll Free Calls	4
C.	No Written Description In The Dual Call Mode Patents Of Using DNIS To Identify A Format	5
D.	No Written Description In The Dual Call Mode, Format Qualification, Or Lottery Patents Of Calling Or Called Number Identification Signals “Automatically” Provided	6
E.	No Written Description In The Format Qualification Or Conditional Interface Patents Of Operators Entering Caller Data.....	9
F.	No Written Description In The Format Qualification Patents Of Providing Voice Operating Instructions To “Specific Ones” Of The Individual Callers.....	11
G.	No Written Description In The Format Qualification Or Lottery Patents Of Using DNIS To Control Processing Of Formats.....	12
H.	No Written Description In The Lottery Patents Of A Generic “Ticket,” “Card,” “Format,” And “Control System”	13
I.	No Written Description In The Lottery Patents Of A Unique Identification Number Providing An Indication That It Has Reached A Predetermined Limit On Use.....	14
J.	No Written Description In The ‘150 Patent Of Testing The Selected Format “In Relation To Said Call Data Signals”	14
K.	No Written Description In The ‘415 Patent Of A “Format” Generally That Is Not Limited To A Game Format	15
L.	No Written Description In The Format Qualification Or ‘965 Patents Of “A” File On “Said Individual Callers”	16

M.	No Written Description In The Format Qualification Patents Of Visually Displaying Customer Number Data, Data From A Data Bank Or Memory Accessed By ANI, Or Identification Data Entered By Callers	17
N.	No Written Description In the Dual Call Mode Patents Of Testing ANI To Determine Whether To Qualify Callers For Communication With The System	19
O.	No Written Description In The ‘965 Patent Of Computer Generated Acknowledgement Numbers	20
P.	No Written Description In The Format Qualification Patents Of “Approval Signals”	20
Q.	No Written Description In The Format Qualification Patents Of Central Memory Accessed By A Plurality Of Interface Switching Structures	21
R.	No Written Description In The Dual Call Mode Patents of Cueing Callers By Synthesized Voice Signals	22
S.	No Written Description In The Format Qualification Patents Of Including Key Numbers “In Packaging of Products”	24
T.	No Written Description In The Format Qualification Patents Of Using Identification Data To Avoid Prompting Certain Callers With Previous Cues.....	25
III.	INVALIDITY FOR CLAIM INDEFINITENESS	26
A.	Claims Reciting Voice Signals To Actuate The Caller’s Terminal Apparatus Are Indefinite	27
B.	Generating Computer Acknowledgement Numbers To Identify The Transaction For “The System” In ‘965:31 Is Indefinite	28
C.	Claims Reciting That Remote Terminals “May Comprise” A Conventional Telephone Instrument Are Indefinite	29
D.	“Certain Individual Callers,” “Said Individual Callers,” And “At Least Certain Of Said Individual Callers” Render ‘965:35, 43, And 53 Indefinite	29
E.	Receiving Signals Indicating A Customer Identification Number “Or” Receiving Responsive Signals Indicative Of Other Data Renders ‘965:61 And 66 Indefinite.....	30
F.	“Means To Receive” Limitations In The ‘863 And ‘065 Patent Claims Fail To Link Structure To The Recited Function.....	31

G.	“Said Additional Call Data Signals ...” In ‘285:23 Is Indefinite	32
H.	System Claims Reciting A Method Step Of Callers Entering Data In The ‘707 And ‘893 Patents Are Indefinite	32
I.	“Processing/Computer Means” And “Means For Processing” In The Format Qualification Patents Are Indefinite For Failure To Link Structure Including Algorithm To The Recited Functions	33
J.	“Analysis Structure” In Claims Of The Format Qualification Patents Is Indefinite For Failure To Link Structure Including Algorithm To The Recited Functions	35
IV.	CONCLUSION	35

TABLE OF AUTHORITIES

CASES

<i>Aristocrat Techs. Australia PTY Ltd. v. Int'l Game Tech.</i> , 2008 WL 819764 (Fed. Cir. Mar. 28, 2008)	27, 34
<i>Atmel Corp. v. Information Storage Devices, Inc.</i> , 198 F.3d 1374 (Fed. Cir. 1999)	26, 32, 34
<i>Bose Corp. v. JBL, Inc.</i> , 274 F.3d 1354 (Fed. Cir. 2001)	26
<i>Cross Med. Prods., Inc. v. Medtronic Sofamore Danek, Inc.</i> , 424 F.3d 1293 (Fed. Cir. 2005)	33
<i>Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.</i> , 412 F.3d 1291 (Fed. Cir. 2005)	26
<i>Eaton Corp. v. Rockwell Int'l Corp.</i> , 323 F.3d 1332 (Fed. Cir. 2003)	22
<i>Festo Corp. v. Shoketsu Kinsoku Kogyo Kabushiki Co.</i> , 535 U.S. 722 (2002)	7
<i>Free Motion Fitness, Inc. v. Cybex Int'l</i> , 423 F.3d 1343 (Fed. Cir. 2005)	8
<i>Hyatt v. Boone</i> , 146 F.3d 1348 (Fed. Cir. 1998)	2, 4, 5
<i>In re Lew</i> , 2007 WL 4201279 (Fed. Cir. 2007)	2, 13, 15
<i>Invitrogen Corp. v. Biocrest Mfg., L.P.</i> , 424 F.3d 1374 (Fed. Cir. 2005)	26
<i>IPXL Holdings, L.L.C. v. Amazon.com, Inc.</i> , 430 F.3d 1377 (Fed. Cir. 2005)	33
<i>Lantech, Inc. v. Keip Machine Co.</i> , 32 F.3d 542 (Fed. Cir. 1994)	11, 23
<i>Lockwood v. Am. Airlines, Inc.</i> , 107 F.3d 1565 (Fed. Cir. 1997)	2
<i>Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.</i> , 248 F.3d 1303 (Fed. Cir. 2001)	27
<i>Pause Tech. LLC v. TiVo Inc.</i> , 419 F.3d 1326 (Fed. Cir. 2005)	7

1	<i>Personalized Media Communications, LLC v. International Trade</i>	
2	<i>Comm'n,</i>	
	161 F.3d 696 (Fed. Cir. 1998)	26
3	<i>Phillips v. AWH Corp.,</i>	
	415 F.3d 1303 (Fed. Cir. 2005)	7
4	<i>Purdue Pharma L.P. v. Faulding, Inc.,</i>	
5	230 F.3d 1320 (Fed. Cir. 2000)	2
6	<i>Reiffin v. Microsoft Corp.,</i>	
	214 F.3d 1342 (Fed. Cir. 2000)	3
7	<i>Security People, Inc. v. Medeco Security Locks, Inc.,</i>	
8	59 F. Supp. 2d 1040 (N.D. Cal. 1999).....	4
9	<i>Tandon Corp. v. U.S. Int'l Trade Comm'n,</i>	
	831 F.2d 1017 (Fed. Cir. 1987)	7
10	<i>Tronzo v. Biomet, Inc.,</i>	
11	156 F.3d 1154 (Fed. Cir. 1998)	1, 5
12	<i>Turbocare Div. of Demag Delaval Turbomachinery Corp. v. General</i>	
13	<i>Electric Co.,</i>	
	264 F.3d 1111 (Fed. Cir. 2001)	2, 3
14	<i>Vas-Cath, Inc. v. Mahurkar,</i>	
	935 F.2d 1555 (Fed. Cir. 1991)	2, 3
15	<i>Verizon California, Inc. v. Ronald A. Katz Technology Licensing,</i>	
16	<i>L.P.,</i>	
	Case No. 01-CV-09871 RGK (RCx).....	1, 3, 4, 5, 9, 10, 12, 21, 25, 31
17	<i>WMS Gaming Inc. v. Int'l Game Tech.,</i>	
18	184 F.3d 1339 (Fed. Cir. 1999)	27

STATUTES

20	35 U.S.C. § 112.....	1, 15, 29, 35
21	35 U.S.C. § 112, ¶ 1	1
22	35 U.S.C. § 112, ¶ 2	26
23	35 U.S.C. § 112, ¶ 6.....	26, 27, 31, 33, 34, 35

I. INTRODUCTION

Defendants move for summary judgment that a substantial number of the claims from the interactive call processing patents selected by plaintiff Ronald A. Katz Technology Licensing, L.P. (“RAKTL”) are invalid for lack of written description or indefiniteness under 35 U.S.C. § 112. This memorandum is supported by a statement of uncontroverted facts (“SUF”) and conclusions of law (“COL”) and the declarations of Dr. Leonard J. Forys and Thomas A. Miller.

The selected claims at issue are from patents that are based on seven different specifications. SUF 1.1.41-1.1.51. From those specifications and others, RAKTL has flooded the Patent Office (“PTO”) with thousands of claims over many years. Many of the defective claims at issue were submitted to the PTO years after the original patent applications were filed, some more than ten years later. Thus, it is not surprising that these later-filed claims lack written description support in the specifications. Many of the claims are invalid for indefiniteness, because they are insolubly ambiguous and their scope cannot be reasonably ascertained.

The record that the Court will need to review is manageable—primarily the patent specifications plus certain relevant portions of the prosecution histories. Moreover, this Court in *Verizon California, Inc. v. Ronald A. Katz Technology Licensing, L.P.*, Case No. 01-CV-09871 RGK (RCx), has already held a number of RAKTL patent claims invalid based on several of the written description defenses asserted below. Thus, this motion can dramatically reduce the number of patent claims at issue in this case.

II. INVALIDITY FOR LACK OF WRITTEN DESCRIPTION

A patent specification must ““contain a written description of the invention, and of the manner and process of making and using it....”” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998) (quoting 35 U.S.C. § 112, ¶ 1). To satisfy this requirement, the specification must reasonably convey to one of skill in the art that the inventor possessed every limitation of the claimed invention at the time of filing. *Id.* A disclosure that merely renders the claimed invention obvious does not meet the written

1 description requirement; the disclosure must describe the claimed invention with all its
2 limitations. *Id.*; *Turbocare Div. of Demag Delaval Turbomachinery Corp. v. General*
3 *Electric Co.*, 264 F.3d 1111, 1119 (Fed. Cir. 2001). Statements in the specification that
4 “the invention” involves a particular element, including such statements in the summary
5 of the invention, are strong evidence that the inventor intended the invention to be
6 limited to embodiments containing that element. *In re Lew*, 2007 WL 4201279 at *3
7 (Fed. Cir. 2007).

8 Although the meaning of terms, phrases, or diagrams in a specification is to be
9 explained from the vantage point of one skilled in the art, all the claim limitations must
10 appear in the specification. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed.
11 Cir. 1997). A specification that does not unambiguously describe all limitations of a
12 claim does not meet the written description requirement. The written description must
13 include all of the limitations in the claim, or it must be shown that any absent text is
14 **necessarily** comprehended in the description and would have been so understood at the
15 time the patent application was filed. *Hyatt v. Boone*, 146 F.3d 1348, 1354-55 (Fed.
16 Cir. 1998); *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323-24 (Fed. Cir.
17 2000) (one skilled in the art must immediately discern the limitation at issue). “It is ‘not
18 a question of whether one skilled in the art might be able to construct the patentee’s
19 device from the teachings of the disclosure.... Rather, it is a question of whether the
20 application necessarily discloses that particular device.’” *Hyatt*, 146 F.3d at 1353.
21 Thus, that the patent specification might possibly disclose the claimed invention is not
22 enough to meet the written description requirement.

23 The written description requirement is often implicated when claims not
24 presented in the patent application as originally filed are added later. *Vas-Cath, Inc. v.*
25 *Mahurkar*, 935 F.2d 1555, 1560 (Fed. Cir. 1991). These later claims must be supported
26 by the original disclosure. “The purpose of [the written description requirement] is to
27 ensure that the scope of the right to exclude, as set forth in the claims, does not
28 overreach the scope of the inventor’s contribution to the field of art as described in the

1 patent specification.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000).

2 None of the claims that Defendants challenge as lacking an adequate written
3 description were included in the patent applications as originally filed. All were added
4 later. By adding those claims later, directed to combinations that are not supported by
5 the original disclosures, RAKTL is overreaching the scope of the contribution to the
6 field of art described in the patent specifications as filed. *Reiffin*, 214 F.3d at 1345.

7 Although compliance with the written description requirement is a fact question,
8 *Vas-Cath*, 935 F.2d at 1563, it may be decided on summary judgment. *See Turbocare*,
9 264 F.3d 1111 (affirming summary judgment of invalidity for lack of written
10 description). RAKTL cannot point to explicit written descriptions in the relevant patent
11 specifications for the claim limitations at issue. And because the specifications do not
12 *necessarily* disclose the claim limitations at issue, the written description requirement is
13 not satisfied. There are no genuine issues of material fact. Summary judgment of
14 invalidity for lack of written description should be granted.

15 **A. No Written Description In The Dual Call Mode Patents Of A**
16 **Plurality Of Formats**

17 The words “respective interface formats,” “an interface format,” and “another
18 interface format” (claim 7 of the ‘223 patent, hereafter ‘223:7); “distinct operating
19 process formats,” “one of the operating process formats,” and “a different one of the
20 operating process formats” (‘223:58); and “plurality of interface formats,” “first
21 interface format,” and “second interface format” (‘223:86) all mean more than one
22 interface or operating process format. COL 2.2.1-2.2.4. In *Verizon*, this Court held
23 claims reciting “a plurality of formats” in the Dual Call Mode patents (including
24 ‘223:107, which like claim 86 depends from claim 80) invalid for lack of written
25 description because the specification only describes a single format. Miller Ex. 30
26 (Order re Verizon’s Motion for Summary Judgment and Katz’s Motion for Summary
27 Judgment, December 2, 2003 (“*Verizon SJO*”) at 78-85); SUF 1.2.6. The above claims
28 are invalid for the same reason. *See Security People, Inc. v. Medeco Security Locks*,

1 *Inc.*, 59 F. Supp. 2d 1040, 1044-46 (N.D. Cal. 1999)(collateral estoppel applied to prior
2 summary judgment of noninfringement).

3 The Dual Call Mode specification describes a single format for a game or contest
4 that is accessible by three different call modes (800, 900, and area code). SUF 1.2.7. A
5 call mode is not the same as a format. SUF 1.2.8. Figure 2 of the specification depicts
6 three call modes but only a single format. SUF 1.2.9-1.2.13. Figure 2 is described as “a
7 flow diagram of *an* operating format of the system of FIG. 1.” SUF 1.2.11. Figure 2 is
8 also described as depicting “the” format, not a plurality of formats. *Id.* In a recent
9 reexamination of the ‘734 Dual Call Mode patent, the PTO agreed, finding that “[t]he
10 ‘734 specification states that Fig. 2 is a *single* format” and “Fig. 2 shows the accessing
11 of the *single* ‘interface format’ accessed by different calling modes....” SUF 1.2.14.

12 None of the passages of the Dual Call Mode specification previously identified by
13 RAKTL’s expert in the *Verizon* case¹ explicitly describes or even mentions a system
14 that operates a plurality of formats. SUF 1.2.15-1.2.18. Nor do any of them implicitly
15 or inherently describe this. SUF 1.2.16. Even RAKTL’s expert admitted that other
16 interpretations of these passages are possible. *Id.* Because those specification passages
17 do not *require* or *necessarily disclose* “a plurality of formats,” that claim limitation is
18 not implicitly or inherently described. *Hyatt*, 146 F.3d at 1353-54.

19 None of the claims included in the application as originally filed recited more
20 than one format. SUF 1.2.19. All of them recited “*an* interface format.” *Id.* Claims
21 reciting more than one format were not submitted until four years later. SUF 1.2.20.
22 Accordingly, ‘223:7, 58, and 86 are invalid because the Dual Call Mode patents only
23 describe a single format, not a plurality of formats. SUF 1.2.21.

24 **B. No Written Description In The Dual Call Mode Patents Of**
25 **Unqualified Or Unverified Toll Free Calls**

26 Selected ‘120:32 and 34 and ‘223:58 recite that the first and second response unit

27 _____
28 ¹ RAKTL’s expert in *Verizon* and *Citibank*, Dr. Lucantoni, is also RAKTL’s expert
here, having submitted declarations in support of RAKTL’s claim construction briefs.

1 means receive toll free calls, but that only “at least” toll free calls received by the first
2 response unit means are qualified or verified. COL 2.2.5, 2.2.7. Selected ‘223:86
3 recites 800 calls for first and second called numbers but verifying “at least” calls for one
4 of the two called numbers. COL 2.2.8. Selected ‘223:5 recites receiving calls in a toll
5 free call mode but not qualification of those calls. COL 2.2.6. Thus, these claims
6 include within their scope toll free calls that are *not* qualified or verified. COL 2.2.9.

7 The specification, however, describes that *all* toll free calls are qualified or
8 verified and the importance of regulating toll free calls. There is no description of
9 unqualified or unverified toll free calls. SUF 1.2.29. In *Verizon*, this Court held that
10 ‘734:81 and 94 and ‘223:107 (which like claim 86 at issue here depends from claim 80)
11 lack written description support because the Dual Call Mode patents only describe a
12 system in which *all* toll free calls are qualified. *Verizon* SJO at 85-87; SUF 1.2.27. The
13 claims at issue here are invalid for the same reason. *See Tronzo*, 156 F.3d 1154 (claims
14 to generic “cup” not supported by description of cups with specific shapes).

15 The specification passages RAKTL cited in *Verizon* for written description
16 support do not describe toll free calls that are unqualified or unverified. Even RAKTL’s
17 expert only asserted that these passages “imply” or “can be taken to mean” that some
18 calls in the toll free call mode can be unregulated. SUF 1.2.30-1.2.32. *See Hyatt*, 146
19 F.3d at 1353-54 (no written description if specification does not require the limitation).

20 None of the originally filed claims recited unqualified or unverified toll free calls.
21 SUF 1.2.33. Such claims were not submitted until four years later. SUF 1.2.34. The
22 claims are therefore invalid for lack of written description. SUF 1.2.35.

23 **C. No Written Description In The Dual Call Mode Patents Of Using**
24 **DNIS To Identify A Format**

25 Selected ‘120:32 and 34 and ‘223:1, 58, and 86 recite using DNIS to identify or
26 select a format. COL 2.2.10-2.2.14. The Dual Call Mode patents, however, do not
27 provide written description support for this limitation. The Court reached this
28 conclusion in *Verizon*, stating that the specification “does disclose that the

1 communication facility is capable of providing DNIS signals to the Katz system, but
2 does not clearly teach how such DNIS signals are used within the Katz system.”²
3 *Verizon SJO* at 85; SUF 1.2.41.

4 DNIS is discussed at only two places in the specification, but those passages only
5 discuss that DNIS is provided to the system, not used to select or identify a format.
6 SUF 1.2.43. The originally filed claims did not recite this (SUF 1.2.44), and no such
7 claims were submitted until four years later. SUF 1.2.45. Accordingly, the claims are
8 invalid for lack of written description. SUF 1.2.46.

9 **D. No Written Description In The Dual Call Mode, Format**
10 **Qualification, Or Lottery Patents Of Calling Or Called Number**
11 **Identification Signals “Automatically” Provided**

12 Selected ‘120:32, 34, 57, 62, 63, and 67, ‘223:1, 3, and 58, ‘021:11, ‘863:5, 27,
13 31, 32, 42, 43, 49, 96, 98, and 99, ‘551:1, 19, 21, 33, and 34, ‘762:30, 32, and 67,
14 ‘547:11, 18, and 19, ‘360:13, 14, 18, 36, and 75, ‘707:201, ‘134:5, ‘065:13, and ‘703:35
15 and 72 all recite “automatically” to describe how called number identification signals or
16 data, such as “DNIS,” and calling number identification signals or data, such as “ANI,”
17 are provided by the communication facility. COL 2.2.15-2.2.38. Because the Dual Call
18 Mode, Format Qualification, and Lottery patents describe DNIS or ANI being
19 “provided” by the communication facility, and not DNIS or ANI being “automatically
20 provided” by the communication facility, these patents do not suggest any definition for
21 “automatically” in this context. COL 2.2.38.

22 While the claims at issue recite DNIS or ANI “automatically provided” by the
23 communication facility, other claims (e.g., ‘863:93 and ‘762:58) simply recite DNIS or
24 ANI “provided” by the communication facility. COL 2.2.39. Because some claims
25 recite “automatically provided” and others recite “provided” by the communication
26 facility, “there is presumed to be a difference in meaning and scope.” *Tandon Corp. v.*

27 ² ‘223:58 and 86 are invalid for the additional reason that they recite identifying first
28 and second formats from a plurality of formats and, as discussed in Section A above, the
specification does not describe a plurality of formats.

1 *U.S. Int’l Trade Comm’n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987); *Pause Tech. LLC v.*
2 *TiVo Inc.*, 419 F.3d 1326, 1334 (Fed. Cir. 2005) (rejecting a construction as it “attaches
3 no significance to the word ‘predetermine.’”); COL 2.2.40.

4 Moreover, the word “automatically” was added by amendment. For example,
5 ‘734 application claim 38 was changed from “a communication facility which provides
6 digital DNIS signals” to “a communication facility which **automatically** provides digital
7 DNIS signals,” and ‘863 application claim 56 was changed from “called number
8 identification signals (DNIS) to identify ...” to “called number identification signals
9 (DNIS) **automatically provided by said communication facility** to identify ...,” without
10 explanation. It is presumed that an unexplained amendment was made for a substantial
11 reason related to patentability, and estoppel applies to limit its scope. *Id.*; *Festo Corp. v.*
12 *Shoketsu Kinsoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739-40 (2002). COL 2.2.41.

13 In view of the differences in claim language and the addition of “automatically”
14 by amendment, “automatically” in the context of automatically provided by the
15 communication facility must be given a meaning that does not render it superfluous.

16 In *Citibank*, RAKTL proposed that “automatically provided” means “provided by
17 a machine or without any human intervention.” COL 2.2.43. That construction
18 improperly reads “automatically” out of the claims. *Id.* The designations “DNIS” and
19 “ANI” refer to signals that have always been provided by machine or without human
20 intervention. COL 2.2.44. DNIS and ANI have never been provided manually.
21 RAKTL’s technical expert has previously admitted this. *Id.* ‘223:3 even recites “...
22 automatic number identification [ANI] signals associated with a calling terminal
23 automatically provided....” COL 2.2.45. Thus, “automatically provided” cannot mean
24 “by a machine or without human intervention,” because if so construed, “automatically
25 provided” would mean the same thing as “provided.” *See Phillips v. AWH Corp.*, 415
26 F.3d 1303, 1314 (Fed. Cir. 2005) (the term “‘steel baffles’ ... strongly implies that the
27 term ‘baffles’ does not inherently mean objects made of steel”). COL 2.2.46.

28 “Automatically” in the context of “automatically providing” DNIS and ANI

1 means “without any external influence or control.” This is consistent with general use
2 dictionaries. COL 2.2.42. This is also consistent with RAKTL’s construction of
3 “automatically” in *AT&T* and the definition offered in technical dictionaries, “self-
4 acting.” *Id.* Defendants propose that “automatically” means “without any external
5 influence or control” (Webster’s Dictionary) because it is more understandable to a jury
6 than “self-acting” from the technical dictionaries.

7 Defendants’ construction is also consistent with the technology. DNIS or ANI
8 may be provided to a call center in many ways, including out-of-band or in-band.
9 COL 2.2.47-2.2.51. In-band signaling is not automatic because the communication
10 facility will not send DNIS or ANI until it first receives an acknowledgment from the
11 call center in response to an indication of an incoming call. *Id.* For example, if the call
12 center is handling too many calls, it will not “wink” back to the communication facility,
13 and DNIS and ANI will not be sent. *Id.* RAKTL’s technical expert has previously
14 agreed with this. COL 2.2.52.

15 Out-of-band signaling (e.g., ISDN), in contrast, is an automatic system; when the
16 call is to be established, the called and calling number digital data are automatically
17 provided by the communication facility to the call center as part of the call setup
18 message. No “wink” is required. Even if the ACD is not ready to receive the call, the
19 communication facility will provide ANI and DNIS. COL 2.2.53. RAKTL’s technical
20 expert has also previously agreed with this. COL 2.2.54. Thus, out-of-band signaling
21 “automatically” provides the DNIS or ANI because it provides them regardless of any
22 external influence or control, as recited in the claims at issue.

23 Accordingly, the Court should adopt Defendants’ construction (without external
24 influence or control) because it is consistent with the claim language, the language of
25 other claims, and the prosecution history. COL 2.2.38-2.2.56; *Free Motion Fitness, Inc.*
26 *v. Cybex Int’l*, 423 F.3d 1343, 1348 (Fed. Cir. 2005) (courts “must ensure that any
27 reliance on dictionaries accords with the intrinsic evidence”).

28 The Dual Call Mode and Format Qualification patent specifications only describe

1 the communication facility “providing” DNIS and ANI, not “automatically” providing
2 DNIS and ANI. SUF 1.2.70-1.2.81. The systems proposed in the patents all require in-
3 band signaling between the communication facility and the call center. No out-of-band
4 channels are available. SUF 1.2.82. For example, the ‘863 and ‘703 patents describe 50
5 lines accommodating 50 calls coming from the automatic call distributors to the
6 processing system. There is no allowance for an out-of-band channel. The patent also
7 indicates that there are 100 lines accommodating 100 calls between the communication
8 facility and an ACD. (‘863 patent, col. 4, l. 12 to col. 5, l. 22; ‘703 patent, col. 5, l. 7 to
9 col. 6, l. 20); *id.* Again, there is no allowance for an out-of-band channel. These lines
10 are depicted in Figure 1 of the patents. *Id.* Likewise, the ‘120 patent describes a single
11 connection for both audio and ANI (‘120 patent, col. 7, ll. 1-11), which is in-band
12 signaling. *Id.* Out-of-band signaling would require two connections. *Id.*

13 Further, the ‘863 and ‘703 patents describe “DNIS capability” and “ANI
14 capability” and those signals being “provided” but not “automatically” provided. SUF
15 1.2.83, 1.2.85. Likewise, the ‘120 patent discusses DNIS and ANI being “provided” but
16 not “automatically” provided. SUF 1.2.84, 1.2.85. And none of the passages relied
17 upon by RAKTL and its expert in *Verizon* describe DNIS and ANI being “automatically
18 provided.” SUF 1.2.86-1.2.92.

19 Claims reciting “automatically” were not submitted until years after the original
20 applications were filed. SUF 1.2.93-1.2.98. Thus, there is no written description in the
21 Dual Call Mode, Format Qualification, and Lottery patents of calling or called number
22 identification signals or data being “automatically” provided as claimed. SUF 1.2.99.

23 **E. No Written Description In The Format Qualification Or**
24 **Conditional Interface Patents Of Operators Entering Caller Data**

25 Selected ‘863:27, 31, 32, 42, 43, and 49, ‘551:1, 21, 33, and 34, ‘065:13, ‘360:13,
26 14, 18, 36, 75, 86, 106, 110, 114, and 119, ‘285:61, and ‘893:1, 2, 4, and 83 recite that
27 live operators enter caller data. COL 2.2.57-2.2.65. That is, *operators* enter caller data
28 through their terminals. COL 2.2.66. The claims further recite that the operator-entered

1 data is stored in the record structure ('863 claims), used to update data in memory ('551,
2 '065, and '360 claims), or processed or processed and stored ('285 and '893 claims). *Id.*

3 The Format Qualification specification describes and depicts in Figure 1 an
4 operator-attended interface terminal IT to which callers can be transferred for direct
5 communication in certain circumstances. SUF 1.2.111. Similarly, the Conditional
6 Interface specification describes and depicts in Figure 1 operator-attended terminals
7 OS1-OSn to which callers can be transferred for communication with the operator.
8 SUF 1.2.112. There is no description in either specification, however, of those
9 operators entering caller data. SUF 1.2.111, 1.2.112. Further, the specifications do not
10 describe operator-entered data being stored, used to update data, or processed and stored
11 as recited in the claims. SUF 1.2.125; *see also id.*

12 By contrast, the '965 patent specification explicitly describes and depicts
13 operators entering caller data in memory. SUF 1.2.113. For example, the '965 patent
14 states that "the process controller 46 along with the lines 48 and 50 are linked to one of
15 the attended terminals AT1-ATn ***enabling an operator to speak directly with a caller***
16 ***and concurrently set data into the data cell register 34 through the controller 46.***" *Id.*
17 Figure 3 in the '965 patent depicts operators inputting caller data beginning with block
18 118, followed by block 128 (where the live interface with an operator is actuated), block
19 130, block 134, and ending with a complete record at block 108. The flow diagrams in
20 Figure 3 of the Format Qualification patents and in Figure 2 of the Conditional Interface
21 patents, however, do not show live operators inputting caller data. *Id.*

22 The passages of the Format Qualification specification previously relied upon by
23 RAKTL in *Verizon* do not provide written description support. SUF 1.2.114-1.2.118.
24 There is also no inherent description in the Format Qualification and Conditional
25 Interface specifications that operators would enter caller data through their terminals as
26 required by the claims because the operators can simply write down data provided by
27 the caller on a piece of paper to be input later by others. SUF 1.2.116-1.2.119.

28 Mr. Katz himself has admitted that caller data taken by an operator may not be

1 entered by the operator but instead by another employee. SUF 1.2.119. And RAKTL's
2 expert previously testified that "completing a partially automated transaction" does *not*
3 inherently mean that the operator completes the transaction by entering data because
4 "[t]he operator can simply write down data for later entry." *Id.* Therefore, the passages
5 describing operators at the interface terminals do not *require* or *necessarily disclose* that
6 those operators enter caller data as recited in the claims. *Id.*

7 Claims reciting operators entering caller data were not submitted until years after
8 the original applications were filed. SUF 1.2.120-1.2.124. Accordingly, there is no
9 written description in the Format Qualification or Conditional Interface patents of
10 operators entering caller data or that such operator-entered data is stored, used to update,
11 or processed and stored as recited in the claims. SUF 1.2.125.

12 **F. No Written Description In The Format Qualification Patents Of**
13 **Providing Voice Operating Instructions To "Specific Ones" Of**
14 **The Individual Callers**

15 Selected '863:182 and 188-192 and '707: 69, 85, 86, and 92 recite that voice (or
16 vocal) operating instructions are provided to "specific ones" of the individual callers to
17 the system. COL 2.2.67-2.2.69. By contrast, other claims recite that vocal operating
18 instructions are provided to "*each* of said individual callers" (e.g., '863:11) or to "said
19 individual callers" ('707:96), not just to "specific ones" of said individual callers. COL
20 2.2.70. Given these differences in language, the words "specific ones" cannot be
21 ignored. *See Lantech, Inc. v. Keip Machine Co.*, 32 F.3d 542, 546 (Fed. Cir. 1994) (all
22 limitations are meaningful).

23 "Specific" means "constituting or falling into a specific category." COL 2.2.71.
24 Therefore, "specific ones of said individual callers" means that a group of callers is
25 determined from the individual callers to the system. Also, the claims recite voice
26 operating instructions, not "specific" voice operating instructions. *Id.* This means that
27 only callers in the select group receive *any* voice operating instructions (although
28 different callers in the select group can receive different instructions), while other

1 callers receive no voice instructions at all. *Id.* This is consistent with RAKTL's
2 proposed construction in *AT&T*, "individual callers chosen from a group." *Id.*

3 The Format Qualification specification, however, describes that voice operating
4 instructions are provided to **all** individual callers to the system. This is depicted in
5 Figure 3 and the accompanying text. Although different callers can receive different
6 instructions, no matter what path a caller takes through this flow diagram, the voice
7 generator is cued to provide operating instructions to the caller (blocks 42, 46, and 56).
8 SUF 1.2.132. There is no description in the specification, including the passages
9 previously relied upon by RAKTL in *Verizon*, of voice instructions being provided to
10 only some of the individual callers. SUF 1.2.132-1.2.134.

11 Nor was this recitation included in the claims as originally filed, and no such
12 claims were submitted until eight years later. SUF 1.2.135-1.2.136. Accordingly, there
13 is no written description of providing voice operating instructions to "specific ones" of
14 the individual callers as recited in the claims. SUF 1.2.137.

15 **G. No Written Description In The Format Qualification Or Lottery**
16 **Patents Of Using DNIS To Control Processing Of Formats**

17 Selected '551:19 and '135:1 and 9 recite using DNIS to control processing of the
18 format. COL 2.2.72, 2.2.73. '135:1 and 9 separately recite identifying a format using
19 DNIS. Thus, "controlling" a format means something different from identifying a
20 format. COL 2.2.74. "Controlling" means directing the operations of the format after
21 the format has been selected. COL 2.2.75. This is consistent with RAKTL's
22 construction of "controlling" in the *AT&T* case in the context of the operations of an
23 interface – "regulate operations of an interface." *Id.*

24 The Lottery patents describe using DNIS to "indicate" the format but not to
25 control the operation of the format. SUF 1.2.142. The Format Qualification
26 specification also does not describe using DNIS to control the operation of a format.
27 SUF 1.2.143. RAKTL's expert in *Verizon* relied on a passage in the specification
28 describing "geographic (or other) classification" as providing a description of DNIS

1 controlling the format. This passage, however, does not describe how this would be
2 accomplished. SUF 1.2.145. The other passages relied upon by RAKTL in *Verizon*
3 also do not describe using DNIS to control the format. SUF 1.2.144, 1.2.145.

4 The originally filed claims in the applications leading to the '551 and '135 patents
5 did not recite using DNIS to control the format. SUF 1.2.146, 1.2.148. Such claims
6 were not filed until over nine and six years later, respectively. SUF 1.2.147, 1.2.149.
7 Thus, there is no written description in the Format Qualification or Lottery patents of
8 using DNIS to control processing of the format as recited in the claims. SUF 1.2.150.

9 **H. No Written Description In The Lottery Patents Of A Generic**
10 **"Ticket," "Card," "Format," And "Control System"**

11 Selected '156:11 recites a "ticket or card" and '135:1 and 9 and 703:35 recite a
12 "ticket." All recite a "format." COL 2.2.76-2.2.78. The Court has interpreted "ticket,"
13 "card," and "format" generically to cover any ticket, card, or format, not just lottery
14 tickets, cards, and formats. COL 2.2.79. Similarly, selected '703:72 recites a generic
15 "telephonic-interface control system." COL 2.2.80, 2.2.81.

16 The specification does not describe any kind of ticket, card, format, or system
17 other than for a lottery. SUF 1.2.159-1.2.160. The patent title is "Telephonic-Interface
18 Lottery System." SUF 1.2.158. The Summary of the Invention states that "the present
19 invention comprises a telephonic-interface lottery system" that uses a "scratch-off
20 lottery ticket." SUF 1.2.159. *In Re Lew*, 2007 WL 4201279 at *3 (description of "the
21 invention" is strong evidence limiting the invention). The only embodiment described
22 ('156 patent, col. 3-13) is a lottery system using lottery tickets. SUF 1.2.160. FIG. 2
23 describes "a scratch-off lottery ticket for use in the system of FIG. 1." *Id.*

24 The originally filed claims only recited "lottery" tickets and formats.
25 SUF 1.2.161. Claims reciting "cards," "tickets," "formats, and "systems" generally
26 were not submitted until much later. SUF 1.2.162-1.2.165. Further, during prosecution
27 of one of the Lottery patent applications, the PTO held that the disclosure of lottery
28 tickets in the specification did not support claims to other kinds of tickets or cards. SUF

1 1.2.166. Thus, there is no written description in the Lottery patents of a “card,” “ticket,”
2 “format,” or “system” generally as claimed. SUF 1.2.167.

3 **I. No Written Description In The Lottery Patents Of A Unique**
4 **Identification Number Providing An Indication That It Has**
5 **Reached A Predetermined Limit On Use**

6 Selected ‘135:1 and 9 recite identification indicia on a substrate of a ticket
7 indicating a unique identification number that provides an indication that the unique
8 identification number has reached a predetermined limit on use. COL 2.2.82. This
9 means that the unique identification number on the substrate must itself indicate that the
10 predetermined limit on use has been reached. COL 2.2.83.

11 While there are a number of references in the specification to the “unique
12 identification number” (SUF 1.2.170), the only description of the unique identification
13 number that relates to a predetermined limit on use is the description that “the number is
14 treated as a consumable key, entitled for example, to a single use for participation.”
15 SUF 1.2.171. The specification, however, does not describe the unique identification
16 number itself having an indication of when the predetermined limit on use has been
17 reached as required by the claims, because the unique identification number on the card
18 cannot be incremented or decremented; it does not change. *Id.*

19 Claims reciting a unique identification number that provides an indication that a
20 predetermined limit on use has been reached were not submitted until almost six years
21 after the original application was filed. SUF 1.2.172, 1.2.173. Accordingly, the claims
22 are invalid for lack of written description. SUF 1.2.174.

23 **J. No Written Description In The ‘150 Patent Of Testing The**
24 **Selected Format “In Relation To Said Call Data Signals”**

25 Selected ‘150:10 and 11 recite testing the selected format “in relation to said call
26 data signals.” COL 2.2.84. “Said call data signals” refers back to “call data signals, as
27 to indicate called and calling numbers” in the preamble. The claims also recite a step of
28 selecting a format before the testing step. COL 2.2.85. Thus, the claims require that the

1 selected format is tested in relation to both called *and* calling number signals (i.e., “said
2 call data signals”) after the format is selected. *Id.*

3 The specification describes an initial test operation “in which the calling number
4 is checked for validity against, for example, a negative list of calling numbers.”

5 SUF 1.2.178. It further describes that after initial qualification, conditions involving
6 time, history, and demographics may be tested in some cases using the calling number
7 or ANI. SUF 1.2.179. None of the foregoing tests, however, involve testing DNIS or
8 testing the selected format in relation to DNIS and ANI. SUF 1.2.177, 1.2.179.

9 None of the originally filed claims recited a step of testing the format in relation
10 to “said call data signals” to conditionally interface the caller to the selected format.
11 SUF 1.2.180. In fact, application claim 11 (which became 150:10) was amended to add
12 the step of “testing the selected format in relation to said call data signals” in response
13 to a § 112 indefiniteness rejection. SUF 1.2.181, 1.2.182. Accordingly, there is no
14 written description in the ‘150 patent of testing the selected format in relation to “said
15 call data signals” as recited in the claims. SUF 1.2.183.

16 **K. No Written Description In The ‘415 Patent Of A “Format”**
17 **Generally That Is Not Limited To A Game Format**

18 Selected ‘415:2 recites “formats” generally, without limiting the type of format to
19 a game format. COL 2.2.86. The Court has construed “format” in ‘415:29 to mean
20 formats generally. COL 2.2.87. Indeed, RAKTL must assert a generic construction of
21 “formats” because Defendants’ accused call center services do not involve games.

22 The specification of the ‘415 patent, however, only describes *game* formats. The
23 title of the patent is “Telephonic-Interface Game Control System.” SUF 1.2.186. The
24 abstract describes a control system “to accommodate game formats.” SUF 1.2.189. The
25 “Prior Art Considerations” section states that a “need exists for expanding operating
26 capabilities, as to accommodate various *game* formats.” SUF 1.2.187. The “Invention
27 Summary” states that “the present invention” is a system and related processes for
28 “game formats or programs.” SUF 1.2.188. *See In Re Lew*, 2007 WL 4201279 at *3

1 (description of “the invention” is strong evidence limiting the invention). Moreover, the
2 only illustrative embodiment described is a game format. SUF 1.2.190.

3 Claims reciting formats generally were not submitted until after the original
4 application was filed. SUF 1.2.191-1.2.192. Thus, there is no written description in the
5 ‘415 patent of formats generally as claimed. SUF 1.2.193.

6 **L. No Written Description In The Format Qualification Or ‘965**
7 **Patents Of “A” File On “Said Individual Callers”**

8 Selected ‘309:46 and 51 and ‘707:24 recite “a” file relating to “said individual
9 callers.” COL 2.2.88, 2.2.89. “Said individual callers” refers back to “individual
10 callers” in the preamble, which means all of the callers to the system. Because the
11 claim uses the word “comprising” in the preamble, “a” file can mean one or more files.
12 Therefore, “a file” on “said individual callers” encompasses updating data for *all* of the
13 callers to the system in a *single* file. COL 2.2.90.

14 Selected ‘965:35, 43, and 53 recite comparing caller identification data received
15 against “a” file on “said individual callers” and then using the identification data to
16 access the file to locate other data associated with the caller. COL 2.2.91. “Said
17 individual callers” in the comparing step has no antecedent basis, but it appears to
18 encompass all of the “said individual callers” that received voice prompts in the prior
19 “prompting” step. Therefore, “a file” on “said individual callers” encompasses data in a
20 single file on all of the callers that received prompts. COL 2.2.92.

21 This language in the above claims is in contrast to other claim language
22 specifically reciting a file for *each* caller, e.g., “to access a file for said individual
23 caller” (‘965:31). COL 2.2.93.

24 The specifications, however, do not describe individual files storing data on all
25 callers. There are only a few references to “file” in the Format Qualification
26 specification. One states that “the customer has a file customer number” that is stored
27 in the block format register 104. The other states that designation unit 96 “updates the
28 file as to current use or dollar value remaining for the caller’s use.” Both references

1 describe a separate file for each caller, not a single file for all callers. SUF 1.2.200. The
2 specification also describes a cell C1 depicted in Figure 2 for storing information on an
3 individual caller, further demonstrating that the specification describes a file for each
4 caller, not a file for all callers. SUF 1.2.201.

5 There are only two references to “file” in the ‘965 patent, one stating that the
6 audio response units “access a file on the caller” and another describing “using a
7 customer’s credit card number to access the file.” SUF 1.2.202. The first reference
8 clearly states that there is “a file” for each caller, and the second suggests this. *Id.*

9 RAKTL did not include claims reciting “a” file relating to “said individual
10 callers” until years after the original applications were filed. SUF 1.2.203-1.2.206.
11 Thus, there is no written description of this claim limitation. SUF 1.2.207.

12 **M. No Written Description In The Format Qualification Patents Of**
13 **Visually Displaying Customer Number Data, Data From A Data**
14 **Bank Or Memory Accessed By ANI, Or Identification Data**
15 **Entered By Callers**

16 Selected ‘360:13, 14, 18, 36, 86, 106, 110, 114, and 119, ‘065:13, and ‘551:21,
17 33, and 34 recite “visually displaying the customer number data” or a portion thereof.
18 COL 2.2.94-2.2.97. Determining that “customer number” does not refer generally to
19 various types of identifications, the Court has construed “customer number” to mean a
20 number assigned to a customer by a vendor or merchant or recognized by a vendor or
21 merchant for the purpose of identification of the customer, and which is distinct from a
22 credit card number. COL 2.2.98.

23 Selected ‘707:201 recites “an attended terminal which displays data obtained
24 from a data bank accessed by said calling number identification data.” COL 2.2.103.
25 “Said calling number identification data” refers back to the term in the interface
26 structure element, which is ANI because it is provided from the communication facility.
27 COL 2.2.104. Therefore, these claims require that all or part of the customer number
28 data or the data from a data bank accessed by ANI be visually displayed. *Id.*

1 Similarly, selected '551:1 recites "automatically receiving caller telephone
2 number data from said telephone facility," "said caller telephone number data being
3 stored in said memory such that said computer means in accordance with said select
4 operating format is capable of accessing said customer data on a selected customer
5 which has a telephone number corresponding to said caller telephone number data
6 automatically provided from said telephone facility" and "visually displaying said
7 customer data." COL 2.2.101. Thus, "visually displaying said customer data" requires
8 displaying data accessed from a memory using ANI. COL 2.2.102.

9 Selected '360:75 recites "receiving caller identification data entered by the
10 callers" and "said computer visually displaying said identification data on a selected
11 caller." COL 2.2.99. "Said identification data" refers to "caller identification data
12 entered by the callers." This claim thus requires that identification data entered by the
13 callers is visually displayed. COL 2.2.100.

14 The specification does not describe visually displaying any of the foregoing types
15 of data. SUF 1.2.220. The specification describes a command CRT computer display
16 terminal CT (Fig. 1). SUF 1.2.221. The specification states that the auctioneer is given
17 certain information regarding the status of the bidding process at terminal CT in the
18 auction format and that "bulk data" is supplied to terminal CT in the polling format but
19 does not describe displaying customer number data, identification data entered by callers,
20 or data from a data bank or memory as claimed. SUF 1.2.221, 1.2.222. RAKTL has
21 previously relied on a passage stating that "the status of the analysis can be televised by
22 selecting a camera focused on the interface terminal IT" in the dramatic broadcast
23 program format as support for "visually displaying customer number data." SUF
24 1.2.223. This does not describe displaying customer number data, identification data
25 entered by callers, or data from a data bank or memory as claimed. *Id.*

26 Claims reciting visually displaying these types of data were not added until years
27 after the original application was filed. SUF 1.2.224-1.2.227. Accordingly, there is no
28 written description of visually displaying the data recited in the claims. SUF 1.2.228.

N. No Written Description In the Dual Call Mode Patents Of Testing ANI To Determine Whether To Qualify Callers For Communication With The System

Selected ‘120:67 recites “testing, to determine whether to qualify the callers for voice-digital communication with the system, the identification signals that indicate the telephone numbers.” COL 2.2.105. The previous “receiving” step recites that those identification signals tested for qualification are ANI signals, because they are provided by the telephone communication facility. COL 2.2.106. The claim is not limited to a particular call mode, and because dependent claim 71 recites “800” and “900” calls, claim 67 necessarily encompasses those call modes. COL 2.2.107.

The specification, however, only describes testing ANI signals for qualification in the area code (ACN) call mode, not in the “800” or “900” call modes. For ACN calls, the specification describes a coincidence test between an approved number sequence of three digits and the last three digits of the calling number (ANI) to determine whether the caller should have access to the system (Figure 2, block 64). SUF 1.2.232. By contrast, for “800” calls, only an identification number input by the caller, not ANI, is tested to verify or qualify callers (Figure 2, block 56). SUF 1.2.233. There is no description of testing “900” calls at all as shown in Figure 2 and the accompanying description. SUF 1.2.234. Thus, even though claim 67 encompasses “800” and “900” calls, there is no description of testing ANI to determine whether to qualify “800” and “900” callers for communication with the system. SUF 1.2.235.

Claims reciting testing ANI to determine whether to qualify callers for communication with the system were not submitted until over five years after the original patent application was filed. SUF 1.2.236, 1.2.237. Accordingly, there is no written description of testing ANI to determine whether to qualify callers for communication with the system as recited in ‘120:67. SUF 1.2.238.

O. No Written Description In The ‘965 Patent Of Computer Generated Acknowledgement Numbers

Selected ‘965:31 recites “generating computer acknowledgement numbers,” and selected ‘956:35, 43, and 53 recite “computer generated acknowledgement numbers.” COL 2.2.108, 2.2.109. This means that a computer generates an acknowledgement number. The Court has already construed “acknowledgement number.” COL 2.2.110.

The ‘965 patent does not describe acknowledgement numbers being computer generated. SUF 1.2.242. The specification only describes acknowledgement numbers being “revealed,” “indicated,” “provided,” “communicated,” “vocalized,” “confirmed,” and “identified,” not computer generated. SUF 1.2.243. Moreover, the acknowledgement numbers discussed in the specification are not inherently or necessarily computer generated, because they could be prepared manually, not by a computer. SUF 1.2.244. By contrast, the Format Qualification patents describe that the processors create acknowledgement digits for the call; no such description is included in the ‘965 patent. SUF 1.2.242, 1.2.243.

The first time claims were submitted reciting “generating computer acknowledgement numbers” or “computer generated acknowledgement numbers” was not until ten years after the original patent application was filed. SUF 1.2.245, 1.2.246. Accordingly, there is no written description in the ‘965 patent of acknowledgement numbers generated by a computer as recited in the claims. SUF 1.2.247.

P. No Written Description In The Format Qualification Patents Of “Approval Signals”

Selected ‘707:69, 85, 86, and 92 and ‘863:1, 2, 5, 182, and 188-192 recite “providing approval signals for qualified individual callers” in the qualifying step and “processing at least certain of said answer data responsive to said approval signals.” COL 2.2.111. An “approval signal” is generated by the system when a caller is qualified for access to the operations of the interface. COL 2.2.112.

The Format Qualification specification mentions caller approval, but does not

1 mention approval *signals*. SUF 1.2.251. By contrast, the earlier '968 patent
2 specification does describe approval signals: "Essentially, the look-up table 122 is
3 indexed and addressed by the identification numbers of callers and responds with
4 *approval signals* for the callers, if appropriate." *Id.* Although the '968 patent is from
5 an earlier application in the chain leading to the Format Qualification patents, the
6 above-quoted passage was not included in the Format Qualification specification. *Id.*

7 Claims were not submitted reciting "providing approval signals for qualified
8 individual callers" until years after the original patent application was filed. SUF
9 1.2.252, 1.2.253. Accordingly, there is no written description in the Format
10 Qualification patents of approval signals as recited in the claims. SUF 1.2.254.

11 **Q. No Written Description In The Format Qualification Patents Of**
12 **Central Memory Accessed By A Plurality Of Interface Switching**
13 **Structures**

14 Selected '551:21, 33, and 34 recite "a plurality of interface switching structures
15 located at different geographic locations" and "processing means connected to the
16 plurality of interface switching structures for receiving customer number data entered by
17 a caller and for storing the customer number data in a central memory accessed by said
18 plurality of interface switching structures." COL 2.2.113. The Court interpreted
19 "placed at spaced apart remote geographic locations" in '134:5 to mean that the
20 interface units "are not in the same place or location, and requires more than mere
21 physical separation at the same location" in *Verizon California, Inc. v. Ronald A. Katz*
22 *Technology Licensing, L.P.*, 326 F. Supp.2d 1060, 1106 (C.D. Cal. 2003). "Located at
23 different geographic locations" should be interpreted in the same way. COL 2.2.114.
24 Thus, the claims require the customer number data in the central memory to be accessed
25 by interface switching structures not in the same place or location. *Id.*

26 The Format Qualification specification does not describe a central memory
27 accessed by a plurality of interface switching structures that are not in the same place or
28 location. In *Citibank*, RAKTL asserted that processors PR1-PRn have a centrally

1 accessible memory. Processors PR1-PRn do not contain a central memory accessed by
2 a plurality of interface switching structures located at different geographic locations.
3 The specification depicts in Figures 1 and 4 that each processor PR1-PRn contains its
4 own dedicated memory 98 (Figure 4). Because processors PR1-PRn (with their
5 memories 1-n) are connected to a single automatic call distributor (AC1), a single
6 interface 20, and a single switch 21, there is no description of a plurality of interface
7 switching structures at different geographic locations that can access a central memory.
8 In fact, Figures 1 and 4 describe many memories connected to a single interface, not a
9 central memory connected to multiple interfaces. SUF 1.2.257-1.2.261.

10 Also in *Citibank*, RAKTL asserted that the embodiment depicted in Figure 9
11 provides written description support for the claim limitations at issue. RAKTL relied
12 upon the statement that “data accumulated in the cells may be downloaded as to a
13 central processing station.” SUF 1.2.262. This passage, however, does not describe a
14 central memory accessed by interface switching structures located at different
15 geographic locations, because there is no central memory described in the specification
16 in connection with the embodiment of Figure 9. *Id.*

17 Claims reciting interface switching structures located at different geographic
18 locations that can access a central memory were not added until years after the original
19 application was filed. SUF 1.2.263, 1.2.264. Thus, there is no written description of
20 this claim limitation in ‘551:21, 33, and 34. SUF 1.2.265.

21 **R. No Written Description In The Dual Call Mode Patents of Cueing**
22 **Callers By Synthesized Voice Signals**

23 Selected ‘223:5 recites “individually cueing said callers” to prompt them to
24 provide digital signals in the means for individually cueing limitation. COL 2.2.115,
25 2.2.116. This limitation has its antecedent basis in “callers are cued by synthesized
26 voice signals” in the preamble, which is therefore a claim limitation. *See Eaton Corp. v.*
27 *Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (“When limitations in the
28 body of the claim rely upon and derive antecedent basis from the preamble, then the

1 preamble may act as a necessary component of the claimed invention.”). COL 2.2.117.
2 The Court has already interpreted “cue” to mean a question or prompt which is given to
3 a caller. COL 2.2.121. The claim specifically recites that callers are cued by
4 “synthesized” voice signals, not simply voice signals. Other claims of the patent, such
5 as claim 3, recite that callers are cued by “voice signals.” *Id.* Therefore, “synthesized”
6 in claim 5 requires a specific type of voice signal. *See Lantech*, 32 F.3d at 546 (all
7 limitations are meaningful).

8 The state of the art, as reflected in articles cited during prosecution of the Dual
9 Call Mode patents, distinguishes between synthesized voice messages and prerecorded
10 voice messages. For example, Yoshizawa, et al. (‘120 patent prosecution) states that
11 “[m]ethods of voice output are divided into two large categories: editing of prerecorded
12 speech, and synthesizing of voice. In the former method, voices representing words and
13 phrases are recorded on a magnetic drum or optical drum and these are edited as
14 necessary at the instruction of a computer.... In the synthesizing method, various
15 control data are combined to produce voices mechanically.” COL 2.2.118. Flanagan,
16 et al. (‘223 patent prosecution) discussed “well known techniques for prerecording
17 natural voice utterances and storing these messages in a computer memory” and “a
18 speech synthesis approach” where “the simple technique of prerecorded natural speech
19 is ruled out.” COL 2.2.119. In view of this state of the art, one of ordinary skill in the
20 art would understand cueing callers with synthesized voice signals to mean that the cues
21 are a collection of audio signals artificially generated by a computer without using
22 recorded human speech. COL 2.2.120.

23 The specification, however, does not describe “synthesized” voice signals. For
24 example, the specification describes giving the caller a simulated voice question from
25 one of the audio response units. SUF 1.2.271. All of the cueing examples in the
26 specification could readily have been done using prerecorded human voice. None of
27 them required the use of synthetic voice. *Id.* Further, the specification does not
28 describe the “complex control system” (Yoshizawa article) that is required for a

1 synthesized voice signal system. The specification only describes audio response units,
2 which typically would be capable of only providing prerecorded cues. SUF 1.2.272.

3 Claims that recited cueing callers by synthesized voice signals were not added
4 until almost two years after the original patent application was filed. SUF 1.2.273,
5 1.2.274. Therefore, there is no written description of cueing callers by synthesized
6 voice signals as recited in '223:5. SUF 1.2.275.

7 **S. No Written Description In The Format Qualification Patents Of**
8 **Including Key Numbers “In Packaging of Products”**

9 Selected '863:182 recites key numbers that “are included in packaging of
10 products.” COL 2.2.122. The patent includes other claims (e.g., '863:188) that recite
11 “providing products carrying key numbers,” but not that the key numbers are included
12 in “packaging” of products. COL 2.2.123. Claim 191 depends from claim 188 and, like
13 claim 182, specifies that the key numbers are “provid[ed] in packaging of products.”
14 Because of this difference in claim language, a person of ordinary skill in the art would
15 understand them to have different meanings. Claim 182 requires that the key numbers
16 be in the packaging of the product, not merely carried on the product. *Id.*

17 The specification describes a key number being carried on the product: “A key to
18 participation in the game show may involve the purchase of a particular product. For
19 example, a person desiring to participate may purchase *a product which carries a*
20 *concealed key number.*” SUF 1.2.278. The specification does not describe that the
21 concealed key number is included *in packaging* of the product. *Id.*

22 Claims reciting key numbers included in packaging of products were not
23 submitted until eight years after the original application was filed. SUF 1.2.279, 1.2.280.
24 Thus, there is no written description in the Format Qualification specification of key
25 numbers being included in packaging of products as claimed. SUF 1.2.281.

T. No Written Description In The Format Qualification Patents Of Using Identification Data To Avoid Prompting Certain Callers With Previous Cues

Selected ‘134:5 requires a central processor that, among other things, performs two functions: (1) “testing the at least certain identification data to control access to at least certain operations of said selected format” and (2) “utilizing the certain identification data to avoid prompting certain callers with a certain previously provided cue or cues.” COL 2.2.124. Based on the Court’s construction of similar language in ‘120:67, the “utilizing ...” phrase in ‘134:5 means using the identification data to prevent callers from receiving one or more specific prompts that the callers previously received. COL 2.2.125.

The ‘134 patent includes a description of the first function (i.e., qualification). For example, the specification describes the caller using buttons on the telephone to input her telephone number and then “testing the telephone number as valid or entitled.” SUF 1.2.284. There is no description of the second function (i.e., cue suppression). SUF 1.2.285. The passages previously relied upon by RAKTL in *Verizon* do not describe this limitation. SUF 1.2.286-1.2.289.

None of the originally filed claims included this limitation. SUF 1.2.290. It was not included until eight years later, when the amended language was described as “subject matter deemed to be previously allowable by the examiner” and reference was made to the same type of language in the ‘120 patent. SUF 1.2.291. But the ‘120 patent is a Dual Call Mode patent, which has a different specification from that of the ‘134 Format Qualification patent. The ‘120 patent *does* describe using identification data to avoid prompting callers with certain cues previously provided to them, for example:

The address numbers from the generator 40 are also supplied to a coincident detector 42 that also receives the address numerals of questions previously presented to a specific caller from a record 44. Thus, before a question is presented to a caller, the number of the calling terminal is

checked to assure that the same question has not previously been posed to a caller at that terminal.

This description is not included in the '134 patent specification. SUF 1.2.292.

Thus, there is no written description in the Format Qualification specification of using identification data to avoid prompting callers with certain previously provided cues as recited in '134:5. SUF 1.2.293.

III. INVALIDITY FOR CLAIM INDEFINITENESS

35 U.S.C. § 112, ¶ 2 requires that the specification conclude with one or more claims “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Claims that fail to meet this requirement are invalid for indefiniteness. *Personalized Media Communications, LLC v. International Trade Comm’n*, 161 F.3d 696, 705 (Fed. Cir. 1998). The issue is one of law for the court. *Id.*

The issue depends on whether those skilled in the art would understand the claim when read in light of the specification. *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999). A claim is indefinite if it “is insolubly ambiguous, and no narrowing construction can be adopted.” *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1383 (Fed. Cir. 2005). If a claim limitation lacks proper antecedent basis and the scope of the claim cannot be reasonably ascertained, the claim is indefinite. *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359 (Fed. Cir. 2001).

A claim reciting a means-plus function limitation is indefinite if the specification fails to clearly link any structure to the function recited in the means-plus-function limitation. *Atmel*, 198 F.3d at 1380. “A structure disclosed in the specification qualifies as ‘corresponding’ structure only if the specification or prosecution history **clearly links** or associates that structure to the function recited in the claim.” *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005) (emphasis added). A patentee’s obligation to clearly link structure to the recited function is the *quid pro quo* for the convenience of employing § 112, ¶ 6. *Id.* That a disclosed structure is capable of performing the recited function does not satisfy the

1 requirement of clearly linking structure to the recited function. *See Medtronic, Inc. v.*
2 *Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1311 (Fed. Cir. 2001).

3 “In a means-plus-function claim in which the disclosed structure is a computer, or
4 microprocessor, programmed to carry out an algorithm, the disclosed structure is not the
5 general purpose computer, but rather the special purpose computer programmed to
6 perform the disclosed algorithm.” *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d
7 1339, 1349 (Fed. Cir. 1999). Disclosure of a general purpose computer as the structure
8 for performing a claimed function amounts to pure functional claiming and does not
9 satisfy § 112, ¶ 6. *Aristocrat Techs. Australia PTY Ltd. v. Int’l Game Tech.*, 2008 WL
10 819764 at *4 (Fed. Cir. Mar. 28, 2008)(affirming summary judgment of invalidity).

11 **A. Claims Reciting Voice Signals To Actuate The Caller’s Terminal**
12 **Apparatus Are Indefinite**

13 Selected ‘968:7, ‘707:24, 69, 85, 86, 92, 115, 116, 129, 130, and 201, ‘863:96, 98,
14 99, 182, and 188-192, and ‘309:46 and 51 recite voice signals or a voice generator
15 structure actuating the caller’s telephone terminal. COL 2.3.1-2.3.5. This claim
16 language is indefinite, because voice signals do not themselves actuate the caller’s
17 telephone; the caller does. COL 2.3.6.

18 This very issue arose during prosecution of RAKTL’s U.S. Patent No. 5,218,631:

19 Also deemed inaccurate is claim 19, lines 14-15, “generating voice signals
20 and supplying said voice signals to actuate said terminal apparatus”
21 (emphasis added), since the “terminal apparatus” (indicated to be the
22 telephone of a caller) obviously is not in fact “actuated” by the voice
23 signals: rather, only the caller does any “actuating” of his or her
24 telephone.

25 The examiner, therefore, rejected claim 19. SUF 1.3.7. Katz responded:

26 The Examiner’s rejection to the specification and Claim 19 has been
27 overcome by amending the claim and deleting the term “actuate.”

28 Accordingly, Claim 19 now recites generating voice signals and supplying

1 said voice signals to said terminal apparatus, to provide vocal operating
2 instructions to a caller.

3 SUF 1.3.8. Other claims of the RAKTL patents do not have this defect. For example,
4 ‘551:14 recites “voice generator structure selectively coupled through the interface
5 structure to the terminals for providing vocal operating instructions to individual
6 callers.” *See also* ‘965:31, which recites cuing to “prompt selective actuation *by an*
7 *individual caller* of said digital input device....” SUF 1.3.9.

8 Instead of selecting claims having accurate language, RAKTL chose to assert
9 claims having the “actuating” language considered by the examiner to be inaccurate.
10 Given this prosecution record, RAKTL cannot now argue that this claim language is
11 not indefinite. Therefore, the claims are invalid. COL 2.3.7.

12 **B. Generating Computer Acknowledgement Numbers To Identify**
13 **The Transaction For “The System” In ‘965:31 Is Indefinite**

14 Selected ‘965:31 recites generating computer acknowledgement numbers to
15 identify the transaction for “the system.” COL 2.3.8. “The system” to which the
16 transaction is identified is not defined in the claim. COL 2.3.9. There is no antecedent
17 basis for “the system.” COL 2.3.10. By contrast, claim 34 similarly recites that
18 “computer generated acknowledgement numbers” are provided “to identify transactions
19 to ... the system,” but unlike claim 31, there is antecedent basis for “the system” in
20 claim 34, i.e., a “system operating a format” in the preamble. SUF 1.3.13.

21 On January 31, 2002, through a request for certificate of correction, RAKTL
22 attempted to “correct” claim 31 by adding “with a system operating a format” (the
23 language in claim 34) into the preamble of the claim. SUF 1.3.14. The PTO did not
24 permit the correction on grounds that it changed the scope of the claim. *Id.*

25 “The system” in the generating step of claim 31 is undefined and, based on the
26 PTO’s action, “with a system operating a format” cannot be read into the preamble of
27 claim 31 to provide antecedent basis for “the system” in the generating step.
28 Accordingly, “the system” in claim 31 of the ‘965 patent is indefinite. COL 2.3.10.

C. Claims Reciting That Remote Terminals “May Comprise” A Conventional Telephone Instrument Are Indefinite

Selected ‘968:7, ‘309:42, 44, 46, and 51, ‘707:24, 115, 116, 129, 130, and 201, ‘863:27, 31, 32, 42, 43, 49, 96, 98, and 99, and ‘285:1, 49, and 61 recite that remote terminals “*may comprise* a conventional telephone instrument.” COL 2.3.11-2.3.13. “May comprise” does not define whether the remote terminals are a conventional telephone instrument or not; they could be something else that is not defined in the claims or specification. COL 2.3.14. This language is ambiguous to a person of skill in the art. COL 2.3.15.

This exact issue arose during prosecution of a number of RAKTL patent applications. In each case, the examiner rejected the claims reciting “may comprise” as indefinite, and in response, the claims were amended to remove that indefinite language. For example, in the application leading to the ‘893 Conditional Interface patent:

Claim 18-20, 22-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite In claim 18, line 4; claim 23, line 3; claim 27, line 6; claim 29, line 5, the phrase “may comprise” is vague and indefinite in that it is not clear as to whether or not the remote terminals do comprise a conventional telephone instrument.

SUF 1.3.21. The claims were then amended to remove the offending “may comprise” language. *Id*; see also SUF 1.3.20, 1.3.22 regarding the ‘762 and ‘156 patents.

RAKTL could have selected claims without this defect, but instead chose to assert the claims at issue, which all recite the “may comprise” language that the patent examiner held to be indefinite. SUF 1.3.23. Accordingly, the claims are indefinite for failing to particularly point out and distinctly claim the invention. COL 2.3.15.

D. “Certain Individual Callers,” “Said Individual Callers,” And “At Least Certain Of Said Individual Callers” Render ‘965:35, 43, And 53 Indefinite

Selected ‘965:35, 43, and 53 recite (1) “remote terminals for use by certain

individual callers” in the preamble and “said certain individual callers” in the interfacing step, (2) “said individual callers” in the receiving, comparing, and providing steps, and (3) “at least certain of said individual callers” in the transferring step. The use of these different phrases suggests that different groups of callers were meant to be encompassed by each term. COL 2.3.16, 2.3.17. A person of ordinary skill in the art cannot determine, however, what group of callers each of these terms is intended to cover, either from the claim language or the specification. COL 2.3.19.

Moreover, the claim language does not make sense to a person skilled in the art. For example, it makes no sense that “said individual callers” are prompted to provide responsive signals, but that only “said certain individual callers” (“certain” connoting a smaller group within the group of “said individual callers”) have remote terminals and are interfaced with the system. COL 2.3.18. The claims are ambiguous and not amenable to construction and therefore indefinite. COL 2.3.19.

**E. Receiving Signals Indicating A Customer Identification Number
“Or” Receiving Responsive Signals Indicative Of Other Data
Renders ‘965:61 And 66 Indefinite**

Selected ‘965:61 and 66 recite, *alternatively*, (1) receiving responsive signals including signals indicative of a customer identification number *or* (2) receiving responsive signals, including signals indicative of other data. COL 2.3.20, 2.3.21. Thus, *either* the customer identification number *or* the other data are received, not both.

The claim further recites in a “testing” step that the customer identification number is tested *and* in a “processing” step that the other data is processed. COL 2.3.21. These two steps require that *both* the customer identification number *and* the other data be received so that they can be tested and processed, respectively.

This creates an insoluble contradiction in the claim. If only customer identification number *or* other data signals are received as recited in the receiving step, it is impossible to carry out both the step of testing the customer identification number and the step of receiving the other data. *Id.* The claims are ambiguous and a person skilled in the art cannot determine their scope. Thus, they are indefinite. COL 2.3.22.

F. “Means To Receive” Limitations In The ‘863 And ‘065 Patent Claims Fail To Link Structure To The Recited Function

Selected ‘863:27, 31, 32, 42, 43, and 49 recite means to receive DNIS “to identify a select one of a plurality of different called numbers associated with a select format of a plurality of different formats.” COL 2.3.23. Selected ‘065:13 recites means for “receiving called terminal digital data (DNIS) signals automatically provided by the telephone facility to identify the select operating format from a plurality of distinct operating formats.” COL 2.3.24. In *Citibank*, the parties agreed that this is a § 112, ¶ 6 limitation. COL 2.3.25, 2.3.26. The parties also agreed that the functions are set out in the above-quoted claim language, in short, using DNIS to identify a select format. *Id.*

The Format Qualification specification, however, does not describe structure linked to this function. In *Verizon*, this Court found that “the ‘065 patent is unclear as to which component selects formats based on called-number identification signals....” *Verizon*, 326 F. Supp. 2d at 1100. While ultimately identifying corresponding structure, *Verizon* did not consider indefiniteness. Even Mr. Katz could not point to disclosure linking structure to the function of using DNIS to select a format. COL 2.3.27.

In *Citibank*, RAKTL argued that the structure corresponding to the receiving means is (a) interface 20, call data analyzer 21a, and associated software; (b) Centrum 9000; or (c) one or more interface units IA1-IA_n, IB1-IB_n and associated software. COL 2.3.28. The specification, however, does not link these structures to the function of using DNIS to select one format from a plurality of formats. COL 2.3.29-2.3.33.

One passage relating to the Figure 1 embodiment cited by RAKTL in *Citibank* only states that the automatic call distributor “associates the called number ... through the interface 20 and switch 21,” not that one of RAKTL’s structures identifies a format. COL 2.3.29. RAKTL’s reliance in *Citibank* on ‘863 patent, col. 10, ll. 28-41 is misplaced because this passage merely describes a coupling through the automatic call distributor AC1, the interface 20 and the switch 21 to a processor PR1 (Figure 1). COL 2.3.30-2.3.32. It does not identify a structure that uses DNIS to identify a select format.

1 *Id.* Further, the specification does not describe interface units IA1-IA_n in the Figure 9
2 embodiment as performing this function. *Id.*

3 Because there is no structure clearly linked to the function in the “receiving
4 means” of ‘863:27, 31, 32, 42, 43, and 49 or to the function in the “means for receiving”
5 of ‘065:13, these claims are indefinite. *Atmel*, 198 F.3d at 1380. COL 2.3.34.

6 **G. “Said Additional Call Data Signals ...” In ‘285:23 Is Indefinite**

7 Selected ‘285:23 depends from claim 22, which recites “providing signal-
8 represented call data from said remote terminals including calling numbers as *additional*
9 *call data signals*.” COL 2.3.35. Claim 23 recites “providing *said additional call data*
10 *signals* automatically from said telephone communication system (e.g. ANI),” referring
11 back to “additional call data signals” in claim 22. *Id.* This means that the ANI signals
12 in claim 23 are provided from the remote terminals (recited in claim 22). COL 2.3.36.

13 This is contradictory to a person skilled in the art. Specifically, the additional call
14 data signals in claim 22 are provided “from said remote terminals,” that is, from the
15 caller’s telephone, depicted as T1 in Figure 1 of the patent. Such call data signals would
16 be input by the caller using the telephone’s touch tone buttons. *Id.* But to those skilled
17 in the art, ANI is only provided by the communication facility, not by the remote
18 terminals as required by claim 23 (which defines ANI as “said additional call data
19 signals,” referring back to “additional call data signals” in claim 22). *Id.*

20 Because there is an irreconcilable conflict between the additional call data signals
21 from the remote terminals in claim 22 and the ANI additional call data signals in
22 claim 23, ‘285:23 is indefinite. COL 2.3.37.

23 **H. System Claims Reciting A Method Step Of Callers Entering Data**
24 **In The ‘707 And ‘893 Patents Are Indefinite**

25 Selected ‘707:116 is directed to “a system” but recites a method step, “wherein
26 said individual callers provide caller credit card number data as said other data.” COL
27 2.3.38. Selected ‘893:1, 2, 4, and 83 are directed to “an interface control system” but
28 recite a method step, “wherein said certain of said individual callers digitally enter

1 data.” COL 2.3.39. Claims mixing system and method limitations are indefinite.

2 In *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir.
3 2005), the claim was directed to “a system” but recited “wherein ... the user uses the
4 input means....” Because the claim recited a system, on the one hand, and a method of
5 using the system on the other hand, the court concluded that it was unclear what acts
6 constituted infringement and held the claim indefinite. COL 2.3.40.

7 Just like the claim at issue in *IPXL Holdings*, ‘707:116 and ‘893:1, 2, 4, and 83
8 are directed to a system but recite a method of using the system. Therefore, they are
9 indefinite because what acts constitute infringement cannot be determined. COL 2.3.41.

10 **I. “Processing/Computer Means” And “Means For Processing” In**
11 **The Format Qualification Patents Are Indefinite For Failure To**
12 **Link Structure Including Algorithm To The Recited Functions**

13 Selected ‘065:13 and ‘551:21, 33, and 34 recite “processing means” that perform
14 four functions: (1) receiving customer number data entered by a caller; (2) storing the
15 customer number data in a memory or central memory; (3) coupling an incoming call to
16 the operator terminal; and (4) visually displaying the customer number data. Similarly,
17 selected ‘551:1 recites “computer means” that performs three functions: (1) connecting
18 an incoming call to the operator terminal; (2) accessing customer data corresponding to
19 caller telephone number data stored in memory; and (3) visually displaying customer
20 data. COL 2.3.42. “Processing means” and “computer means” should be construed as §
21 112, ¶ 6 limitations. *See, e.g., Cross Med. Prods., Inc. v. Medtronic Sofamore Danek,*
22 *Inc.*, 424 F.3d 1293, 1307 (Fed. Cir. 2005) (“means” creates a presumption that § 112,
23 ¶ 6 applies). COL 2.3.43.

24 The specification discloses that only processors PR1-PRn (*see* Fig. 1), specifically
25 processing unit 92 (*see* Fig. 4) of the processors, receives and stores customer number
26 data in a memory and couples an incoming call to an interface terminal. SUF 1.3.51.
27 Accordingly, the processing unit 92 must be part of the corresponding structure for
28 processing and computer means. The specification discloses that processors PR1-PRn

1 “may comprise a microcomputer, for example, programmed as suggested above and as
2 disclosed in detail below to accomplish specific operating formats.” *Id.* The
3 specification further discloses that processing unit 92 “may take the form of a mini-
4 computer programmed to accommodate the functions of various applications” *Id.*
5 However, the specification does not clearly link or associate any algorithm for
6 processors PR1-PRn, or more specifically processing unit 92, to perform the recited
7 functions. COL 2.3.46. Furthermore, as discussed in Section II.M above, the
8 specification does not disclose visually displaying customer number data.

9 RAKTL’s prosecuting agent (Kuyper) testified that algorithms are unnecessary
10 because they are “known to one of ordinary skill in the art.” SUF 1.3.52. But “[a]
11 patent holder cannot evade [the corresponding structure] requirement with a conclusory
12 assertion that one skilled in the art would understand the claimed means despite the
13 failure to disclose a structure.” *Atmel*, 198 F.3d at 1378; *see also Aristocrat Techs.*,
14 2008 WL 819764 at *7 (an argument that a skilled person could build the claimed
15 device without a disclosed algorithm improperly conflates the enablement requirement
16 and the requirement to disclose corresponding structure under § 112, ¶ 6). COL 2.3.48.
17 In fact, Ms. Kuyper testified that none of the RAKTL patents contain an algorithm.
18 SUF 1.3.52. Thus, ‘065:13 and ‘551:1, 21, 33, and 34 are indefinite. COL 2.3.49.

19 Selected ‘707:115, 116, 129, and 130 recite “means for processing at least certain
20 of said data developed by said terminals and said calling number identification data....”
21 COL 2.3.50. The parties agree that this is a § 112, ¶ 6 limitation and that unit 92 (“a
22 mini-computer programmed to accommodate the functions of various applications”)
23 is part of the corresponding structure (although the parties disagree about what other
24 structures should be included). (D.I. 735-2, Parties’ Pre-Briefing Proposed and Agreed
25 Claim Constructions at 7). COL 2.3.51. Similarly, selected ‘863:96, 98, and 99 recite
26 “means for processing at least certain of said answer data signals....” COL 2.3.52. This
27 “means for processing” limitation should also be treated under § 112, ¶ 6. COL 2.3.53.
28 For the reasons discussed above with respect to the ‘065 and ‘551 patents, the

1 specification fails to link any algorithm for performing the recited functions, and the
2 ‘707 and ‘863 patent claims are likewise indefinite. COL 2.3.54, 2.3.55.

3 **J. “Analysis Structure” In Claims Of The Format Qualification**
4 **Patents Is Indefinite For Failure To Link Structure Including**
5 **Algorithm To The Recited Functions**

6 Selected ‘021:11, ‘309:42, ‘551:19, and ‘547:11, 18, and 19 recite an “analysis
7 structure.” COL 2.3.56. The Court has ruled that “analysis structure” is a § 112, ¶ 6
8 limitation, that the function is processing data, and that part of the corresponding
9 structure is processing unit 92. COL 2.3.57. The Court reserved ruling on whether
10 claim 42 was indefinite for no disclosure of an algorithm for processing unit 92 to
11 perform the recited function. *Id.*

12 As discussed in Section III.I above, the Format Qualification specification
13 discloses that processing unit 92 “may take the form of a mini-computer programmed to
14 accommodate the functions of various applications” SUF 1.3.59. But the
15 specification does not *clearly link or associate* any algorithms for processing unit 92 to
16 perform the recited function (i.e., “processing said caller data signals” or “processing at
17 least certain of the data relating to certain individual callers”). COL 2.3.60. The
18 specification discloses a variety of operations that processing unit 92 may perform (*see*,
19 *e.g.*, ‘065 patent, col. 3, ll. 23-43, col. 9, ll. 52-54), but does not clearly link any of the
20 numerous aspects of the processing unit 92, or any algorithm to the recited function.
21 COL 2.3.61. Accordingly, the claims are indefinite. COL 2.3.62.

22 **IV. CONCLUSION**

23 In view of the law and facts discussed herein, the accompanying uncontroverted
24 facts and conclusions of law and declarations, summary judgment should be entered that
25 the above-identified claims are invalid under 35 U.S.C. § 112.

26 Date: April 3, 2008

27 By: /s/ Matthew J. Moore

28 Matthew J. Moore
Liaison Counsel for Defendants